

### **REMARKS**

Claims 1-22 are currently pending. Claims 5, 10, and 15-20 have been withdrawn from consideration. Reexamination and reconsideration of the pending claims is respectfully requested.

#### **Claim Rejections – 35 U.S.C. § 102**

The Examiner rejected Claims 1, 3, 6, 21, and 22 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,388,815 (“Hill815”).

Hill815 does not teach or suggest the subject matter of independent Claim 1. Specifically, Hill815 does not teach a binding line or an optical disk. Rather, Hill815 discloses an embossed card package production system 10 that produces embossed and encoded credit cards mounted to carrier forms. The system 10 includes an embosser section 20 and an inserter section 24. The embosser section 20 embosses alphanumeric characters on the face of the card and magnetically encode like information on a magnetic stripe on the back of the card. The inserter section 24 inserts the embossed and encoded cards into carrier forms.

The Examiner indicates that the embosser section 20 is a binding line. Applicants respectfully disagree. The act of embossing a plastic card with a number is not a binding process. Nothing is being bound.

The Examiner also indicates that Hill815 discloses an optical disk. Applicants respectfully disagree. The Examiner identifies, by using the numerals in Hill815, the subject matter in Hill815 that illustrates or discloses the claimed elements of Claim 1. However, the Examiner fails to identify the optical disk in the reference.

For at least the reasons noted above, Hill815 does not teach or suggest the subject matter of Claim 1. Accordingly, independent Claim 1 is allowable.

Claim 3 depends from Claim 1 and is allowable for at least the reasons Claim 1 is allowable. Hill815 does not teach or suggest the subject matter of Claim 3. Rather, Hill815 discloses that the printed information on the carrier form is printed independently of the credit card being embossed. Then, in a downstream operation, the credit card and the carrier form are matched-up. The carrier form is not printed based on what was written to the optical disk. Accordingly, Claim 3 includes additional patentable subject matter.

Hill815 does not teach or suggest the subject matter of independent Claims 6, 21, and 22 for at least the reasons discussed above with respect to Claim 1. In addition, with respect to

Claims 21 and 22, Hill815 does not teach or suggest delivering a plurality of printed products to the binding line based upon information written to or read from the optical disk. Rather, Hill815 only matches-up the credit card with the carrier form, which already exists on the system 10. The system 10 of Hill815 does not receive any other items.

The Examiner also rejected Claims 11, 13, 14, and 22 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,431,453 ("Hill453").

Hill453 does not teach or suggest the subject matter of independent Claim 11. Specifically, Hill453 does not teach a binding line or an optical disk. Rather, Hill453 discloses a smart card verification system 10 including a smart card verifying inserter 60.

The Examiner indicates that a pre-encoded smart card source 76 is a binding line. Applicants respectfully disagree. The pre-encoded smart card source 76 is just a location where smart cards are stored. The verification system 10 is just that – a verification system. The system 10 does not perform a binding process and nothing is being bound.

The Examiner also indicates that Hill453 discloses an optical disk. Applicants respectfully disagree. The Examiner identifies, by using the numerals in Hill453, the subject matter in Hill453 that illustrates or discloses the claimed elements of Claim 11. However, the Examiner fails to identify the optical disk in the reference.

For at least the reasons noted above, Hill453 does not teach or suggest the subject matter of Claim 11. Accordingly, independent Claim 11 is allowable.

Claims 13 and 14 depend from Claim 11, and are allowable for at least the reasons Claims 11 is allowable. Claims 13 and 14 specify an optical disk, which as noted above is not disclosed in Hill453.

Hill453 also does not teach or suggest the subject matter of independent Claim 22. Hill453 does not disclose delivering a plurality of printed products to the binding line based upon information read from the optical disk. Rather, Hill453 only matches-up the credit card with the carrier form, which already exists on the system 10. The system 10 of Hill453 does not receive any other items.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejected Claims 1-3, 6-7, and 21-22 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,126,201 ("Pace") in view of Hill815.

Pace does not teach or suggest the subject matter of independent Claim 1. As acknowledged by the Examiner, Pace does not teach or suggest writing electronic information to an optical disk on a binding line. Office Action dated October 28, 2004, page 3.

Hill815 does not cure the deficiencies of Pace. Hill815 does not teach or suggest a binding line or an optical disk. Rather, Hill815 discloses an embossed card package production system 10 that produces embossed and encoded credit cards mounted to carrier forms. The system 10 includes an embosser section 20 and an inserter section 24. The embosser section 20 embosses alphanumeric characters on the face of the card and magnetically encode like information on a magnetic stripe on the back of the card. The inserter section 24 inserts the embossed and encoded cards into carrier forms.

The Examiner indicates that the embosser section 20 is a binding line. Applicants respectfully disagree. The act of embossing a plastic card with a number is not a binding process. Nothing is being bound.

The Examiner also indicates that Hill815 discloses an optical disk. Applicants respectfully disagree. The Examiner identifies, by using the numerals in Hill815, the subject matter in Hill815 that illustrates or discloses the claimed elements of Claim 1. However, the Examiner fails to identify the optical disk in the reference.

In addition, there is no suggestion or motivation to combine the references. Pace discloses a folder 50 including a compact disc assembly 80. The assembly 80 includes a planar paperboard base portion 82, a compact disc 52 supported on one surface 83 of the base portion 82, and an outerwrap, or covering 84. Col. 5, lines 11-15. Once the compact disc 52 is positioned within the folder 50, information cannot be written to or read from it. The folder 50 is forwarded to other manufacturers for processing. There is no suggestion to modify the system of Pace to write information to or read information from the disc. The discs include the necessary content before being added to the folder 50. There is no suggestion to even verify the contents of the disc prior to inserting the folder 50 in a magazine.

For at least the reasons noted above, Pace and Hill815 do not teach or suggest the subject matter of Claim 1. Accordingly, independent Claim 1 is allowable.

Claims 2 and 3 depend from Claim 1, and are allowable for at least the reasons Claim 1 is allowable. Pace does not teach or suggest the subject matter of Claim 3. As noted above, Pace does not teach or suggest reading information from the disc to be able to print personalized indicia on a printed product.

Hill815 does not cure the deficiencies of Pace. Rather, Hill815 discloses that the printed information on the carrier form is printed independently of the credit card being embossed. Then, in a downstream operation, the credit card and the carrier form are matched-up. The carrier form is not printed based on what was written to the optical disk.

In addition, there is no suggestion or motivation to combine the references for the reasons discussed above with respect to Claim 1. Accordingly, Claim 3 includes additional patentable subject matter.

Pace and Hill815 do not teach or suggest the subject matter of independent Claims 6, 21, and 22 for at least the reasons discussed above with respect to Claim 1. In addition, with respect to Claims 21 and 22, Pace and Hill815 do not teach or suggest delivering a plurality of printed products to the binding line based upon information written to or read from the optical disk. Rather, the system of Pace only positions a disc in a folder, and Hill815 only matches-up the credit card with the carrier form, which already exists on the system 10. The system 10 of Hill815 does not receive any other items.

In addition, there is no suggestion or motivation to combine the references for the reasons discussed above with respect to Claim 1. Accordingly, Claims 6, 21, and 22 are allowable.

The Examiner rejected Claims 4 and 8-9 under 35 U.S.C. § 103 as being unpatentable over Pace in view of Hill815 and further in view of U.S. Patent No. 5,114,128 ("Harris").

Claim 4 depends from Claims 1 and 3 and is allowable for at least the reasons Claims 1 and 3 are allowable. As noted above, Pace and Hill815 do not teach or suggest the subject matter of Claims 1 and 3. Harris does not cure the deficiencies of Pace and Hill815. Harris does not teach or suggest an optical disk.

Harris also does not teach or suggest printing personalized indicia on the printed product after associating the optical disk with the printed product. Rather, Harris teaches that a pre-personalized signature 16a is deposited on the chain 12 and a bar code reader 58 reads a bar code. The bar code information is transmitted to an ink jet printer to print name and address

information to a magazine cover. Col. 9, lines 11-22. The personalized signature is a part of the printed product and does not require being associated with another printed product.

In addition, there is no suggestion or motivation to combine Pace, Hill815, and Harris. As noted above, Pace and Hill815 cannot be combined. Harris cannot be combined with Pace and Hill815. Harris requires the ability to read a bar code in order to instruct a downstream printer to print appropriate information. As discussed above, the disc in Pace is enclosed and information cannot be written to or read from the disc. Accordingly, Claim 4 includes additional patentable subject matter.

Claims 8 and 9 depend from Claim 6 and are allowable for at least the reasons Claim 6 is allowable.

As noted above, Pace and Hill815 do not teach or suggest the subject matter of Claim 6. Harris does not cure the deficiencies of Pace and Hill815. Harris does not teach or suggest an optical disk

Harris also does not teach or suggest printing personalized indicia on the printed product in response to what was read from the optical disk and that the printing of personalized indicia occurs after associating the optical disk with the printed product. Rather, Harris discloses that a pre-personalized signature 16a is deposited on the chain 12 and a bar code reader 58 reads a bar code on the pre-personalized signature. The bar code information is transmitted to an ink jet printer to print name and address information to a magazine cover. Col. 9, lines 11-22. The personalized signature is not an optical disk and is a part of the printed product and does not require being associated with another printed product.

In addition, there is no suggestion or motivation to combine Pace, Hill815, and Harris. As noted above, Pace and Hill815 cannot be combined. Harris cannot be combined with Pace and Hill815. Harris requires the ability to read a bar code in order to instruct a downstream printer to print appropriate information. As discussed above, the disc in Pace is enclosed and information cannot be written to or read from the disc. Accordingly, Claims 8 and 9 include additional patentable subject matter.

The Examiner rejected Claim 12 under 35 U.S.C. § 103 as being unpatentable over Hill453 in view of Harris.

As noted above, Hill453 does not teach or suggest the subject matter of Claim 11. Harris does not cure the deficiencies of Hill453. Harris does not teach or suggest an optical disk, reading electronic information from an optical disk on a binding line, or associating the optical disk with a printed product. Rather, Harris discloses that a pre-personalized signature 16a is deposited on the chain 12 and a bar code reader 58 reads a bar code on the pre-personalized signature. The pre-personalized signature is a part of a magazine. The bar code information is transmitted to an ink jet printer to print name and address information to a magazine cover. Col. 9, lines 11-22. The personalized signature is not an optical disk and is a part of the printed product and does not require being associated with another printed product.

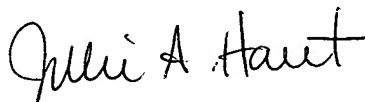
In addition, there is no suggestion or motivation to combine Hill453 and Harris. There is no suggestion to combine the operations of a credit card system that matches a credit card with a carrier and a printing system that generates magazines.

For at least the reasons noted above, Hill453 and Harris do not teach or suggest the subject matter of Claim 12. Accordingly, Claim 12 includes additional patentable subject matter.

### **CONCLUSION**

In view of the above remarks, Applicants respectfully request allowance of the pending claims. The undersigned is available during normal business hours if a telephone conversation would be helpful to advance prosecution in this application.

Respectfully submitted,



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